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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/728,705      | 12/01/2000  | Eugene Owen JR.      | 36968-195514        | 4891             |

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EXAMINER

JASMIN, LYNDIA C

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Applicati n No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/728,705             | OWEN, EUGENE        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Lynda C Jasmin         | 3627                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: On page 6, descriptions of Figures 5a and 5b are missing.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Smorodinsky (6,049,786).

Smorodinsky disclosed a method and system of automatically tracking and balancing account receivable data as claimed for

a) submitting a billing data file (via complete bills) to a processing entity (via bill presentment computer) the billing data file having customer account records

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representing accounts receivable for a given Carrier (as illustrated in Figures 2a and 2b);

- b) separating the customer account records into at least two tracking data sets based on pre-defined criteria (via bill status);
- c) computing the total amount of accounts receivable located in each tracking data set related to a given Carrier(via program 18);
- d) comparing the total amount of pre-processed accounts receivable related to a given Carrier to the total amount of processed accounts receivable related to said Carrier (col. 5, lines 28-50);
- e) creating a discrepancy report comprising Carriers whose total amount of preprocessed accounts receivable do not equal the total amount of processed accounts receivables (col. 2, lines 61-64); and
- f) creating a settlement report for each Carrier whose total amount of pre-processed accounts receivable submitted equals the total amount of processed accounts receivable (col. 2, line 65 – col. 3, line 5).

Smorodinsky also discloses routing the discrepancy report to at least one location accessible to at least one discrepancy source-identifier (biller), and routing the settlement report to at least one location accessible to at least one end-user of the settlement report (via 53a). Where the at least one location is a workstation (10) connected to the processing entities system (20) by a local network (via communication channels 41, 43, 42). The customer account records have a unique means (via bill reference number ID) to identify the Carrier that generated the customer account

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record. The customer account records further have a customer account number (via account number). The customer account records further have the amount payable for services rendered by the Carrier (via current charges). The customer account records further have the billing cycle in which the customer account is payable (via billing period). The billing cycle is the criteria used to separate the customer account records into the tracking data sets (via bill status code). The tracking data sets include a Billed data set where the Billed data set comprises customer account records with accounts payable in the current billing cycle (via bill posted). The tracking data sets include an unbilled data set where the unbilled data set comprises customer account records with accounts payable in a future billing cycle (via bill reviewed). The tracking data sets include an Error data set where the Error data set comprises invalid customer account records (via disputed billed). Further, the settlement report comprises the amount of accounts receivable located in each tracking data set relating said Carrier (via amount of payment which was authorized). Smorodinsky further discloses establishing an agreement between a plurality of Carriers (here NCI) and a processing entity (California Bell), the Carriers agreeing to submit billing data files to the processing entity and the processing entity agreeing to process the billing data files and remit payment to Carriers (inherently recited via clearing settlement services).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smorodinsky in view of Remington et al. (6,070,150).

Smorodinsky discloses the elements of the claimed invention, however fails to explicitly disclose having a reconciliation device.

Remington discloses the concept of using a bill format in a manner that allows electronic remittance information to seamlessly integrate with a biller's reconciliation process.

From this teaching of Remington, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the bill presentment of Smorodinsky to include the standard data used to reconcile a statement taught by Remington in order to collect from a consumer.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kolling et al. (5,963,925), Loeb et al. (6,006,205), Thomas et al. (6,173,272), Heindel et al. (6,304,857) are cited as art of interest.

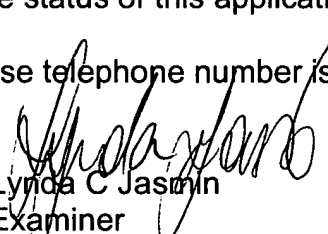
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda C Jasmin whose telephone number is (703) 305-

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0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.



Lynda C Jasmin  
Examiner  
Art Unit 3627

lj  
February 9, 2003